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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,626	12/05/2003	John A. Griego	06530.0318	9106
22852	7590	05/04/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			KASZTEJNA, MATTHEW JOHN	
		ART UNIT	PAPER NUMBER	
		3739		

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/727,626	GRIEGO ET AL.
	Examiner	Art Unit
	Matthew J Kasztejna	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 December 2003.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-110 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-110 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 05 December 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/5/03 &amp; 4/14/05</u> .	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,967,997 to Turturro et al. in view of U.S. Patent No. 5,741,429 to Donadio, III et al.

**In regards to claims 1, 15, 18, 31-32, 43-44 and 51-52,** Turturro et al. discloses a medical device comprising a proximal handle 12; a distal assembly 14 for performing a medical procedure, and a wire coil 16 connecting the proximal handle to the distal assembly, wherein actuation of the proximal handle causes both deflection of the distal portion and actuation of the distal assembly to perform the medical procedure. wherein actuation of the proximal handle causing the distal assembly to perform the medical procedure and the distal portion of the wire coil has a flexibility greater than a flexibility of the proximal portion. (see Col. 4, Lines 10-32) but is silent with respect to the wire coil having a proximal portion comprised of a first wire and a distal portion comprised of a second wire, wherein the second wire has a diameter less than a diameter of the first wire. Donadio, III et al. teach of an analogous flexible tubular device for insertion into the body during medical procedures wherein by varying the configuration of the multi-wire coil, a coated flexible tubular member 20 of varying characteristics can be formed.

For example, increasing the size of the filaments will result in increased hoop strength but less flexibility. Moreover, varying the configuration of the multi-wire coil along the length of the flexible tubular member 20 can result in a flexible tubular member 20 with varying characteristics. For example, the middle section of the flexible tubular member 20 could be made more flexible by reducing the diameter, reducing the number of filaments, increasing the spacing between filament coils, etc. A flexible tubular member 20 could also be made where the distal end is very flexible and the proximal end is very stiff to improve the transmission of a torque at the proximal end to the distal end (see Col. 6, Line52 – Col.7, Line14). It would have been obvious to one skilled in the art at the time the invention was made to have a coil wire comprising a first proximal wire portions and a second distal wire portion with a smaller diameter in the apparatus of Turturro et al. to provide a tubular section with varying flexibility characteristics as taught by Donadio, III et al.

**In regards to claims 2 and 17,** Turturro et al. discloses a medical device, wherein the wire coil at the distal portion 60 has an outer diameter that is less than an outer diameter of the wire coil at the proximal portion 58 (see Col. 4, Lines 30).

**In regards to claims 3, 34, 45 and 54,** Turturro et al. discloses a medical device, wherein the device is configured to selectively deflect the distal portion relative to the proximal portion (see Fig. 6).

**In regards to claims 4, 19 and 46,** Turturro et al. discloses a medical device, further comprising a jacket covering an outer surface of the proximal portion (see Col. 4, Lines 30).

**In regards to claims 5-6, 20-21, 29-30 and 49-50,** Turturro et al. discloses a medical device wherein the proximal portion includes a first outer jacket, but is silent with respect to wherein the distal portion includes a second outer jacket, wherein the second outer jacket is made of a material different than a material of the first outer jacket. Donadio, III et al. teach of an analogous flexible tubular device for insertion into the body during medical procedures wherein varying the configuration of the multi-wire coil along the length of the flexible tubular member 20 can result in a flexible tubular member 20 with varying characteristics. For example, the variation of the composition and thickness of the coating material will also vary the flexibility of the coated flexible tubular member (20) (see Col. 8, Lines 20-24). It would have been obvious to one skilled in the art at the time the invention was made to have a second jacket made of a different material than the first jacket in the apparatus of Turturro et al. to provide a tubular section with varying flexibility characteristics as taught by Donadio, III et al.

**In regards to claims 7-10 and 23-25,** Turturro et al. discloses a medical device, wherein actuation of the handle causes at least one of actuation of the distal assembly and deflection of the distal portion (see Col. 2, Lines 53-67).

**In regards to claims 11, 26-27, 35-38, 47 and 55,** Turturro et al. discloses a medical device, further comprising a deflection control member 17, wherein the deflection control member is configured to hold the distal portion in a deflected position (see Fig. 6 and Col. 7, Lines 27-46).

**In regards to claims 12-13, 39-41, 48 and 56,** Turturro et al. discloses a medical device, wherein the handle includes a first actuation member for actuating the

distal assembly and a second actuation member for deflecting the distal portion (see Col. 7, Lines 27-46).

**In regards to claims 14, 28 and 42,** Turturro et al. discloses a medical device, wherein the distal assembly includes a biopsy forceps assembly 44 (see Fig. 3).

**In regards to claims 22, 33 and 53,** Turturro et al. discloses a medical device, wherein the elongated member 13 includes a wire having substantially the same diameter (see Col. 4, Lines 34-49).

**In regards to claims 57-110,** the combined apparatus of Turturro et al. and Donadio, III et al. is considered to be inherently capable of the recited method steps.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S Patent No. 6,569,105 to Kortenbach et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

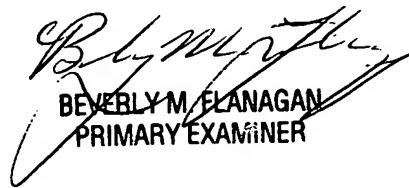
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK

MK

4/27/05



BEVERLY M. FLANAGAN  
PRIMARY EXAMINER